REMARKS

Claims 1-15, 17-23 and 26-29 are pending in this application. Claims 1, 5-8, 10, 11, 13, 17-23 and 26 have been amended. Claims 2-4, 9, 12, 14 and 15 remain unchanged. Claim 25 has been cancelled, without prejudice. Claims 27-29 have been added. No new matter has been introduced.

Claims 1-15, 17-21, 25 and 26 stand rejected under 35 USC §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant claims as his invention. In response, claims 1 and 26 are amended herein to delete the language ("sufficient depth so that...") considered by the Examiner to be vague and indefinite and to substitute recitation of structural limitations that more properly characterize Applicant's invention and distinguish his invention over the prior art, as follows:

> the [opposite] lower surface defining a recessed region disposed around the aperture, the recessed region serving to position said lower cushion surface of said first cushion spaced above the floor or ground surface, including when said first cushion deforms and flows under the wearer's weight and force of heel strike.

These amendments apply also to claims 2-14 and 17-21, which depend from claim 1, and to new claims 27-29, which correspond to claims 18, 20 and 21 and depend from claim 26. Claim 25 has been cancelled without prejudice.

Turning next to the rejections over the prior art. Claims 1, 4-6, 11, 12, 15, 17 and 26 are rejected under 35 USC §102(b) as being anticipated by Fuerst U.S. 4,897,936. Claims 1-4, 11, 15 and 26 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Preston U.S. 5,287,638 in view of Fuerst '936. Claims 1 and 5-9 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Duclos U.S. 4,724,624 in view of Fuerst '936. Claims 1 and 10 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Parisotto U.S. 5,768,806 in view of Fuerst '936. Claims 1, 5, 6, 11 and 13-15 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Dyer et al. U.S. 5,325,611 in view of Fuerst '936. We respectfully traverse.

Applicant's invention, as now more clearly claimed, is directed to a shoe comprising an outsole sole having a cushion, disposed in an aperture of the outsole, that deforms and flows toward the floor or ground surface upon application of the wearer's weight and the force of heel strike, with the cushion remaining in a recess of the outsole, spaced from contact with the floor or ground surface. None of the prior art references cited by the Examiner, whether taken alone, or in any proposed combination, teaches or suggests Applicant's invention.

In particular, Fuerst '936 describes a sole construction for an athletic shoe having a dome-shaped portion designed to contact the floor surface during play, e.g., at col. 3, lines 24-29 says:

> The dome-shaped portion 58 has a height less that the thickness of the outer sole and does not engage the floor or ground *until sufficient weight is applied to it by the weight of the player, at which time it will assume the configuration shown in phantom outline in FIG. 5.* [emphasis provided]

Clearly, the shoe sole of Fuerst '936 is designed and constructed so that the dome-shaped portion 58 is brought into contact with the floor or ground surface during its expected manner of use. This is in sharp contrast to the shoe of Applicant's invention, in which the cushion is designed and constructed to flow through the aperture, but to at all times remain spaced from contact with the floor or ground surface, in order to provide the intended level of cushioning to the toddler new to walking.

There is no teaching or suggestion in the athletic shoe of Fuerst '936 for a cushion, disposed in an aperture of the outsole, that deforms to flow toward the floor or ground surface when pressure is applied, with the cushion *remaining in a recess of the outsole, spaced from contact with the floor or ground surface.*

Similarly, in Preston '638, a pad 26 is slightly higher in relation to a shock absorber surface 25, so that the pad provides a strike area that contacts the walking surface first. Then, as body weight is applied, the plug body 23 makes a secondary contact of its surface 25 with the floor or ground surface to absorb the energy that would normally be applied only to the pad 26. (col. 2, lines 41-48).

There is no teaching or suggestion in the shoe of Preston '638 for a cushion, disposed in an aperture of the outsole, that deforms to flow toward the floor or ground

surface when pressure is applied, with the cushion *remaining in a recess of the outsole, spaced from contact with the floor or ground surface.*

Both Fuerst '936 and Preston '638 teach shoes in which a slightly recessed cushion is brought to bear upon a floor or ground surface to absorb energy otherwise applied to the surrounding areas of the shoe sole (see Fuerst '936 at col. 3, lines 31-32, "The arrangement provides a superior cushioning effect..." and see Preston '638 at col. 2, lines 47-48, "...to absorb energy that would normally be applied only to the pad 26.") In contrast, in the child's shoe of Applicant's invention, "Since recess portion 40 on the lower surface 20 of outsole 10 is spaced from the ground, the portion of the cushion 70 protruding through apertures 42 and 44, even when force is applied to the cushion, *does not contact the ground.*" (page 6, lines 19-21, emphasis provided) Neither Fuerst '936 nor Preston '638 teaches or suggests Applicant's invention for a shoe with a cushion that remains spaced from contact with the ground or floor surface, and even if those references may be properly combined in the manner proposed by the Examiner, which Applicant does not concede, the product of such a combination would still result in a shoe with a recessed cushion positioned to bear on the ground or floor surface under expected conditions of use.

The other prior art references cited in combination with Fuerst '936 similarly lack any teaching or suggestion for the features of Applicant's invention found lacking in Fuerst '936 and Preston '638. In particular, Duclos '624 is cited by the Examiner for its description of a shoe with an outsole having a grid and loop pattern; Parisotto '806 is cited for its description of a shoe with a grid pattern in a top surface of the outsole, and Dyer et al. '611 is cited for its description of footwear with a "comfort cradle" in a midsole region.

Claims 22 and 23 are rejected under 35 USC §102(b) as being anticipated by Pavone U.S. 6,009,637. Claims 1, 3, 4, 12, 15 and 17-23 are rejected under 35 USC §103 as being obvious and therefore unpatentable over Pavone '937 in view of Fuerst '936. We respectfully traverse.

Claim 22 has been amended to recite first and second cushions adapted, under the wearer's weight and force of heel strike, to, respectively, deform and flow toward the floor or ground surface and deform outwardly at a cut-out portion in the sidewall. As described above, the lower surface of the outsole defines a recessed region that serves to position the lower

cushion surface of the first cushion spaced above the floor or ground surface, including when the first cushion deforms and flows under the wearer's weight and force of heel strike.

In contrast, Pavone '637 describes a "Helium Footwear Sole" in which helium modules formed by a core of silicone are *visible* through openings in the sole (col. 1, lines 60-67). Helium flows between modules when a module receiving pressure is compressed. There is, however, no teaching or suggestion for a cushion that deforms to flow from an aperture, toward a floor or ground surface, when pressure is applied.

The Examiner also proposes to combine Fuerst '936 and Pavone '637. As discussed above, Fuerst '936 specifically provides for contact of his dome-shaped cushion with the floor or ground surface under expected conditions of play, in order to obtain "a superior cushioning effect..." (col. 3, lines 31-32). Pavone '637 teaches a shoe with modules held permanently in place, spaced from floor contact by hard rubber supports. Cushioning is provided by movement of gas among modules, and there is no teaching or suggestion for flow of cushioning material through apertures toward a floor or ground surface. Therefore, even if these references could be combined in the manner proposed by the Examiner, which Applicant does not concede, the combined product would not result in the shoe of Applicant's invention.

On the basis of the above, we submit that all of the claims, as now amended, are distinguished over the prior art and therefore in condition to be allowed.

The specification and claim 19 are also amended herein in order to more properly characterize the window or *slot* 46, as shown in FIGS. 5 and 6.

Attached is a marked-up version of the changes being made by the current amendment.

We submit that this application is now in condition for allowance. Early favorable action is solicited. Enclosed is a Petition for Automatic Extension of Time (one month, large entity) with check for $462.00 in payment of the extension fee and in payment of the fee for excess claims. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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Version with markings to show changes made

In the specification:

Paragraph beginning at page 5, line 13 has been amended as follows:

--As shown in FIGS. 5 and 6, sidewall 12 of the outsole 10 along heel section 14 may include a cut-out portion 46 in the form of a window or slot [slit].--

In the claims:

Claim 25 has been cancelled, without prejudice.

Claims 1, 5-8, 10, 11, 13, 17-23 and 26 have been amended as follows:

--1. (Twice Amended) A shoe comprising:

an outsole having an upper surface, [a] an opposite lower surface, and a heel section, the upper surface being positioned relatively closer to a wearer's foot and the lower surface being positioned to engage upon a floor or ground surface when the shoe is worn during walking, the outsole further [having] defining an aperture in the heel section extending from the upper surface to the opposite lower surface; and

a resilient, [flexible] deformable first cushion disposed in said aperture, with a upper cushion surface of said first cushion disposed at a region of [on] the upper surface of the [member] outsole in the heel section[,] and a lower cushion surface of said [the] first cushion [being shaped to protrude through the aperture;] disposed at a region of the lower surface of the outsole in the heel section,

said first cushion being adapted to deform and flow toward the floor or ground surface under the wearer's weight and force of heel strike, and

the lower surface [including] defining a recessed [portion,] region disposed around the aperture, the recessed [portion] region serving to position said lower cushion surface of said first cushion spaced above the floor or ground surface when said first cushion deforms and flows, including under the wearer's weight and force of heel strike [having sufficient depth so that a lower surface of the first cushion will not contact a walking surface when the wearer is walking].--

--5. (Twice Amended) The shoe according to claim 1 wherein the lower surface of the outsole has [a] at least one groove formed therein to enhance the flexibility of the outsole.--

--6. (Twice Amended) The shoe according to claim 5 wherein the outsole has a width, and at least one of said [the] at least one groove substantially traverses the width of the outsole.--

--7. (Twice Amended) The shoe according to claim 5 wherein the outsole has a perimeter, and at least one of said [the] at least one groove has a closed-loop shape substantially parallel to the perimeter of the outsole.--

--8. (Twice Amended) The shoe according to claim 5 wherein the at least one groove has a substantially semi-circular shape.--

--10. (Twice Amended) The shoe according to claim 1 or claim 9, wherein the upper surface of the outsole has a grid pattern formed therein to enhance the flexibility of the outsole.--

--11. (Twice Amended) The shoe according to claim 1 wherein the first cushion includes a protrusion that protrudes through the aperture at the region of said opposite lower surface of the outsole.--

--13. (Twice Amended) The shoe according to claim 1 or claim 12, wherein the first cushion further comprises a flexible, resilient sheet.--

--17. (Twice Amended) The shoe according to claim 1 wherein the outsole [includes] defines a plurality of apertures.--

--18. (Twice Amended) The shoe according to claim 1 wherein the outsole further comprises a sidewall along the heel section of the [member] outsole, the sidewall including a cut-out portion.--

--19. (Twice Amended) The shoe according to claim 18 wherein the cut-out portion is a [slit] slot.--

--20. (Twice Amended) The shoe according to claim 18 further comprising a second cushion disposed in the [member] outsole adjacent to the cut-out portion.--

--21. (Twice Amended) The shoe according to claim 20 wherein the second cushion deforms and flows outwardly at [is shaped to protrude through] the cut-out portion during heel strike.--

--22. (Twice Amended) A shoe [outsole] comprising:

an outsole [a member] having an upper surface, a lower surface, a heel section, and a sidewall along the heel section, the [member] outsole further [having] defining an aperture in the heel section extending from the upper surface to the lower surface and a cut-out portion in the sidewall;

a resilient, deformable first cushion disposed in said aperture, with a upper cushion surface of said first cushion disposed at a region of the upper surface of the outsole in the heel section and a lower cushion surface of said first cushion disposed at a region of the lower surface of the outsole in the heel section; and

a resilient, [flexible] deformable second cushion disposed on the upper surface of the [member] outsole in the heel section,

said first cushion being adapted to deform and flow toward the floor or ground surface under the wearer's weight and force of heel strike, and said [the] second cushion being shaped to deform outwardly at [protrude through the aperture and to protrude through] the cut-out portion; and

the lower surface defining a recessed region disposed around the aperture, the recessed region serving to position said lower cushion surface of said first cushion spaced above the floor or ground surface when said first cushion deforms and flows under the wearer's weight and force of heel strike.--

--23. (Twice Amended) The shoe outsole according to claim 22 wherein the first cushion includes a protrusion that protrudes [through] at the aperture.--

--26. (Amended) A shoe comprising:

an outsole having an upper surface, [a] an opposite lower surface, and a heel section, the upper surface being positioned relatively closer to a wearer's foot and the lower surface being positioned to engage upon a floor or ground surface when the shoe is worn during walking, the outsole further [having] defining an aperture in the heel section extending from the upper surface to the opposite lower surface; and

a resilient, [flexible] deformable first cushion disposed in said aperture, with a upper cushion surface of said first cushion disposed at a region of [on] the upper surface of the [member] outsole in the heel section[,] and a lower cushion surface of said [the] first cushion

[being shaped to protrude through the aperture;] disposed at a region of the lower surface of the outsole in the heel section, the first cushion comprising a polymeric, gelatinous material;

said first cushion being adapted to deform and flow toward the floor or ground surface under the wearer's weight and force of heel strike;

the upper surface including a recessed [portion] region[,] disposed around the aperture, for receiving the first cushion; and

the opposite lower surface [including] defining a recessed [portion,] region disposed around the aperture, the recessed [portion] region serving to position said lower cushion surface of said first cushion spaced above the floor or ground surface when said first cushion deforms and flows, including under the wearer's weight and force of heel strike [having sufficient depth so that a lower surface of the first cushion will not contact a walking surface when the wearer is walking].--